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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,720	01/26/2004	Gilad Odinak	INTL-1-1039	2555
25315	7590	02/08/2006	EXAMINER	
BLACK LOWE & GRAHAM, PLLC 701 FIFTH AVENUE SUITE 4800 SEATTLE, WA 98104			ZEWARI, SAYED T	
			ART UNIT	PAPER NUMBER
			2687	

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/765,720

Applicant(s)

ODINAK, GILAD

Examiner

Sayed T. Zewari

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5 and 6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 5 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 5 and 6 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 and 2 of U.S. Patent No. 6,748,244. Although the conflicting claims are not identical, they are not patentably distinct from each other because the reference discloses a method which can only be implemented using computer programs running in a processor. The applicant claims a computer program product running on processor in the phone that perform the same functions and implement the same methods as the reference. Therefore it is obvious that both the applicant and reference claims are essentially similar.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 5 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Shah (US 2002/0,068,543).

With respect to claim 5, Shah discloses a computer program product residing on a phone embedded in a vehicle (See Shah's section [0008], [0026]) for performing a method for automatically using a service plan of a personal mobile phone over the phone embedded within the vehicle (See Shah abstract, section [0002], [0003], [0015], [0016], [0055], [0046], and [0047]). Shah further discloses the method comprising: detecting the presence of the personal mobile phone (See Shah section [0055], [0046], and claims 3 and 4); receiving a mobile subscriber identification number from the detected phone (See Shah section [0047], [0048], where Shah discusses detection and authentication); sending the mobile subscriber identification number to a wireless network authority; sending an authentication request to the personal mobile phone; receiving a confirmation of the authentication; sending the confirmation of the authentication to the wireless network authority (See Shah section [0047], [0048],

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[0049], [0050], and [0051] where Shah discusses detection, synchronization, and authentication signaling); ending communication between the personal mobile phone and the embedded phone (See Shah section [0052], [0055]); and opening a communication session with the wireless network based on the sent confirmation (See Shah section [0047], [0048], [0049], [0050], and [0051] where Shah discusses synchronization and authentication).

With respect to claim 6, Shah discloses a computer program product residing in a phone embedded within a vehicle (See Shah abstract, section [0008], [0026], [0046], and [0054]), the computer program product comprising: a first component for detecting the presence of a personal mobile phone (See Shah section [0055], [0046], and claims 3 and 4, where a component is a program module performing a specific task); a second component for receiving a mobile subscriber identification number from the detected phone (See Shah section [0047], [0048], where Shah discusses detection and authentication); a third component for sending the mobile subscriber identification number to a wireless network authority; a fourth component for sending an authentication request to the personal mobile phone; a fifth component for receiving a confirmation of the authentication request; a sixth component for sending the confirmation of the authentication request to the wireless network authority (See Shah section [0047], [0048], [0049], [0050], and [0051] where Shah discusses detection, synchronization, and authentication signaling); a seventh component for ending communication between the personal mobile phone and the embedded phone (See

Shah section [0052], [0055]); an eighth component for opening a communication session with the wireless network based on the sent confirmation (See Shah section [0047], [0048], [0049], [0050], and [0051] where Shah discusses synchronization and authentication).

Conclusion

The following prior arts made of record and not relied upon are considered pertinent to applicant's disclosure.

Yamamoto U. S. Patent Publication No. 2002/0,142,803 discloses a mobile communication terminal and care mounted electronic device.

Reed et al. U. S. Patent No. 4,876,710 discloses a method and apparatus for cordless microphone communication system.

Kinnunen U. S. Patent publication No. 2002/0,173,347 discloses a hand free operation of mobile terminal using wireless communication link.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sayed T. Zewari whose telephone number is 571-272-6851. The examiner can normally be reached on 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester G. Kincaid can be reached on 571-272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sayed T. Zewari

February 3, 2006


NICK CORSARO
PRIMARY EXAMINER